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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,265	02/11/2004	Nischal Abrol	990607C1	5392
23696	7590	01/10/2006	EXAMINER	
QUALCOMM, INC 5775 MOREHOUSE DR. SAN DIEGO, CA 92121			MEHRPOUR, NAGHMEH	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,265

Applicant(s)

ABROL ET AL.

Examiner

Naghmeh Mehrpour

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 1-23**, are rejected on the ground of nonstatutory double patenting over claim 1-27 of U. S. Patent No. 6,542,734 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

3. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: They are all related to using a mobile station application interface between a mobile station application and a mobile station protocol stack in order to identify a plurality of specified events.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 1-2, 5-8, 10-13, 15-22**, are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as admitted by applicant on pages 1-6 of the present specification in view of Cook (6,016,511).

As to **claims 1-2, 6-7, 11-12, 15, 20-22**, the admitted prior art discloses in figure 2 a mobile station 110 using application protocol 200 and protocol stack (see numerals 202-212). The admitted prior art further discloses registering a specified event such as read operation (see the present specification page 9 lines 25-27. *It should be noted that the protocol stack 280 in figure 3 and page 9 lines 25-27 is exactly the same as the protocol stack 202-212 in figure 2 of the admitted prior art*). The admitted prior art, however, fails to disclose associating the specified event with a particular condition to be satisfied in order to enable the specified event, and waiting for notification from the communication protocol stack that indicates that the registered specified event has been enabled. Cook discloses associating a specified event with a particular condition to be satisfied in order to enable the specified event, and waiting for notification from protocol 28 that indicates that the registered specified event has been enabled (see columns 3-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Cook to the admitted prior art, in order to allow much greater flexibility in using protocol applications while maintaining device performance (as suggested by Cook at column 2 lines 15-21)

As to **claims 3, 8, 13, 17, 22**, the admitted prior art discloses in figure 2 a mobile station 110 using application protocol 200 and protocol stack (see numerals 202-212). The admitted prior art further discloses registering a specified event such as write operation (see the present specification page 9 lines 25-27. *It should be noted that the*

protocol stack 280 in figure 3 and page 9 lines 25-27 is exactly the same as the protocol stack 202-212 in figure 2 of the admitted prior art).

As to **claims 5, 10, 19**, the admitted prior art discloses in figure 2 a mobile station 110 using application protocol 200 and protocol stack (see numerals 202-212). The admitted prior art further discloses registering a specified event such for mobile operation (see the present specification page 9 lines 25-27. *It should be noted that the protocol stack 280 in figure 3 and page 9 lines 25-27 is exactly the same as the protocol stack 202-212 in figure 2 of the admitted prior art).*

7. **Claims 4, 9, 14, 18, 23**, are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as admitted by applicant on pages 1-6 of the present specification in view of Cook (6,016,511) as applied to above claims and further in view of in view of Morris (6,112,206).

As to **claims 4, 9, 14, 18, 23**, the admitted prior art discloses in figure 2 a mobile station 110 using application protocol 200 and protocol stack (see numerals 202-212). The admitted prior art further discloses registering a specified event such as close operation (see the present specification page 9 lines 25-27. *It should be noted that the protocol stack 280 in figure 3 and page 9 lines 25-27 is exactly the same as the protocol stack 202-212 in figure 2 of the admitted prior art).* The admitted prior art modified by Cook fails to disclose socket as claimed. However, Morris discloses communication network comprising socket used in a standard interface (see column 14 lines 21-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide socket in Morris to the admitted prior art modified by Cook, so that the mobile station application interface in the admitted prior art modified by Cook can be used with standard protocol.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fletcher et al. (6,363,477) disclose application program interface 420 interfacing protocol application 410 and protocol stack (see figure 4).

9. **Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.

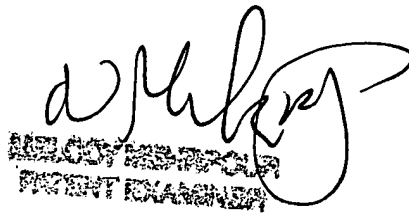
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold be reached (571) 272-7905.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

January 6, 2006



A handwritten signature in black ink is written over a rectangular official stamp. The stamp contains the text "ALCOA PATENT" in a bold, sans-serif font, with "PATENT" on the top line and "ALCOA" on the bottom line. The signature is a cursive-style name, possibly "A. M. Kelly", written in a fluid, connected script.